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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,463	04/15/2004	Jean-Michel Challe	P25036	6207

7055 7590 07/16/2007
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EXAMINER	
MOHANDESI, JILA M	

ART UNIT	PAPER NUMBER
3728	

NOTIFICATION DATE	DELIVERY MODE
07/16/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.	Applicant(s)	
10/824,463	CHALLE, JEAN-MICHEL	
Examiner	Art Unit	
Jila M. Mohandesi	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-21 is/are allowed.
- 6) ☒ Claim(s) 1-18, 22-27, 35-44 and 48-52 is/are rejected.
- 7) ☒ Claim(s) 28-34 and 45-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-5, 11, 14-15, 18 and 40-42, 44 and 48-52 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Abel (3,289,328) in view of Caplan (2,003,105). Abel discloses a foot cover/liner (5) assembled along a first longitudinal assembly seam (18) and a second substantially vertical assembly seam (17), both longitudinal and substantially vertical seams being arranged on only one side of the shoe (see column 2, lines 1-8) and being the only seams for assembling the upper portion of the liner (7) to the bottom portion of the liner (6). See figures 1-4 embodiments and column 1, lines 31-37. This foot cover/liner is worn on a users foot, which is then inserted inside of an article of footwear, which inherently will have upper and a bottom assembly/outer sole. Contrary to Applicant's argument the examiner is not

relying on the sole wall (6) of Abel's sport sock to correspond to Applicant's claimed "bottom assembly", the "bottom assembly" which the examiner is relying on is part of the article of the footwear which is worn over the sock liner of Abel.

Abel discloses that it is desirable to have the longitudinal and vertical seams only on one side of the foot cover/liner. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the seams of the cover/liner of Abel on the longitudinal side of the footwear as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well on either the medial or longitudinal side of the footwear. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

It appears that the seam (15) of Abel, which secures the edges of the upper portion together, is slightly slanted and not completely vertical. However Caplan discloses that it is desirable to connect the edges of the liner with a vertical seam. Accordingly, the skilled artisan would have been motivated to substitute the slanted seam of Abel for a vertical seam insofar as they are art-equivalents.

With respect to claim 2, Abel discloses that it is well known in the art to provide heel stiffener arranged on an exterior of said foot cover/liner. See column 1, lines 20-27.

With respect to claim 5, the liner is made of terry stretch cloth, which is extensible and ventilated.

With respect to claim 11, official notice is taken that it is old and conventional to provide a shock absorbing sole to a footwear to make the footwear more comfortable for

the user. Since applicant did not challenge the limitation under Official Notice, the limitation under Official Notice is now taken as admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the admitted prior art to provide a shock absorbing sole to the footwear of Abel to make the footwear more comfortable for the user.

With respect to claim 4, official notice is taken that it is old and conventional to provide an outer gusset in the heel area of a liner/upper adapted to receive heel stiffeners and foam to provide more comfort to the wearer. Since applicant did not challenge the limitation under Official Notice, the limitation under Official Notice is now taken as admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the admitted prior art of record to provide a gusset in the heel area of the liner/upper to receive the heel stiffener and to also provide a foam within the gusset between the liner and the heel stiffener to make the footwear more comfortable for the wearer.

With respect to claim 40, it would have been obvious to one of ordinary skill in the art at the time the invention was made to eliminate the inner sole, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 136 USPQ 184.

4. Claims 1-2, 10, 14-18, 40-44 and 48-52 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Zaino (US 4,447,967) in view of Abel (3,289,328) and Caplan (2,003,105). Zaino discloses an article of footwear comprising: an upper; a

bottom assembly (Sole , see column 2, lines 23-28); the upper comprising a liner (fabric sock) assembled together and two tightening quarters arranged on medial and lateral sides of the upper, respectively, each of the tightening quarters being attached at a lower end to the upper in an area of the bottom assembly (bands 14), and each of the tightening quarters is provided at the upper end with lacing guides (eyelets 7). Zaino does not appear to disclose the liner having longitudinal and vertical seams that are the only seams for assembling the liner together. Abel discloses a foot cover/liner (5) assembled along a first longitudinal assembly seam (18) and a second substantially vertical assembly seam (17), both longitudinal and substantially vertical seams being arranged only on one side of the shoe (see column 2, lines 1-8) and being the only seams for assembling the upper portion of the liner (7) to the bottom portion of the liner (6). See figures 1-4 embodiments and column 1, lines 31-37. Abel discloses that it is desirable to have the longitudinal and vertical seams only on one side of the foot cover/liner. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the seams on the longitudinal side of the footwear as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well on either the medial or longitudinal side of the footwear. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

It also appears that the seam (15) of Abel, which secures the edges of the upper portion together, is slightly slanted and not completely vertical. However Caplan discloses that it is desirable to connect the edges of the liner with a vertical seam.

Accordingly, the skilled artisan would have been motivated to substitute the slanted seam of Abel for a vertical seam insofar as they are art-equivalents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the liner of Zaino with the modified liner of Abel-Caplan to make the liner more comfortable and a liner, which can be economically manufactured from one-piece of blank.

With respect to claim 2, Zaino discloses a heel stiffener/reinforcement (11), see figure 2 embodiment.

With respect to claim 17, whether the fixing means is a bonding or stitching or any other art recognized equivalent is an obvious matter of choice, such as to require less manual dexterity to operate.

With respect to claim 18, see column 2, lines 16-21.

5. Claims 1-18, 40-44 and 48-52 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Norton et al. (US 4,451,996) in view of Abel (3,289,328) and Caplan (2,003,105). Norton discloses an article of footwear comprising: an upper; a bottom assembly (outsole 12 and midsole); the upper comprising a liner (fabric lamina 32) assembled together and two tightening quarters arranged on medial and lateral sides of the upper, respectively, each of the tightening quarters (34 and 36) being attached at a lower end to the upper in an area of the bottom assembly by stitched seams, and each of the tightening quarters is provided at the upper end with lacing guides (eyelets 44). Norton does not appear to disclose the liner/upper having longitudinal and vertical seams that are the only seams for assembling the liner

together. Abel discloses a foot cover/liner (5) assembled along a first longitudinal assembly seam (18) and a second substantially vertical assembly seam (17), both longitudinal and substantially vertical seams being arranged on only one side of the shoe (see column 2, lines 1-8) and being the only seams for assembling the upper portion of the liner (7) to the bottom portion of the liner (6). See figures 1-4 embodiments and column 1, lines 31-37. Abel discloses that it is desirable to have the longitudinal and vertical seams only on one side of the foot cover/liner. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the seams on the longitudinal side of the footwear as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well on either the medial or longitudinal side of the footwear. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

It also appears that the seam (15) of Abel, which secures the edges of the upper portion together, is slightly slanted and not completely vertical. However Caplan discloses that it is desirable to connect the edges of the liner with a vertical seam. Accordingly, the skilled artisan would have been motivated to substitute the slanted seam of Abel for a vertical seam insofar as they are art-equivalents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the liner of Norton with longitudinal and vertical seams that are the only seams for assembling the liner together as taught by the modified liner of Abel-Caplan to make the liner more comfortable.

With respect to claim 2, Norton discloses a heel stiffener/reinforcement (counter 18), see figure 1 embodiment.

With respect to claims 3 and 4, Official Notice is taken that it is old and conventional to provide an outer gusset in the heel area adapted to receive heel stiffeners and foam to provide more comfort to the wearer. Since applicant did not challenge the limitation under Official Notice, the limitation under Official Notice is now taken as admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the admitted prior art to provide a gusset in the heel area of the liner to receive the heel stiffener and to also provide a foam within the gusset between the liner and the heel stiffener to make the footwear more comfortable for the wearer.

With respect to claim 5, the liner is made of fabric material.

With respect to claims 6-9, note the outer protective layer, outer layer (mesh lamina 28).

With respect to claim 17, whether the fixing means is a bonding or stitching or any other art recognized equivalent is an obvious matter of choice, such as to require less manual dexterity to operate.

6. Claims 22-27 and 35-39 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (4,438,574). Johnson discloses an article of footwear (10) comprising: a bottom assembly (sole 20 and midsole 22); an upper (12) comprising: an extensible, ventilated material (inner layer 40 made of breathable, stretchable and moldable material such as leather); and an outer protective covering layer positioned

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over said extensible, ventilated material (outer layer 42 preferably made of synthetic mesh, non-stretchable nylon material) at a front section of the upper, said outer protective cover layer comprising a nylon mesh material. See Figures 1 and 2 embodiments.

With respect to claims 26 and 27, note the reinforcing gusset (Heel reinforcing members 32 and 34) assembled to the upper in a heel zone, the gusset extends forwardly on lateral and medial sides of the article of footwear toward the outer protective covering layer.

With respect to the material of the inner layer being textile, Johnson discloses that the inner layer can be made of leather or a leather-like material, Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the inner layer to be textile, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claims 38 and 39, it is well known to provide an inner sole beneath the upper and above the outer sole to provide more cushioning and comfort to the wearer or not to provide an inner sole so a firmer feeling.

With respect to claims 35 and 36, Official Notice is taken that it is old and conventional to fix a liner to an article of footwear to prevent the liner from being removed from the footwear.

Allowable Subject Matter

7. Claims 19-21 allowed.
8. Claims 28-34 and 45-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed 04/09/2007 have been fully considered but they are not persuasive. In response to applicant's argument that the instant application uses the mesh for preventing penetration of foreign material to the textile material, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
July 06, 2007